

REMARKS

This communication responds to the *Office Action* dated December 11, 2009. Claims 1, 5, 15, and 19 are amended, no claims are canceled, and no claims are added. As a result, claims 1-28 remain pending in this application.

The Rejection of Claims Under § 102

On page 2, paragraph 5 of the *Office Action*, the Examiner rejected claims 1-28 under 35 U.S.C. 102(e) as being anticipated by *Matheson* (U.S. 6,944,514). Without conceding the propriety of the Examiner's characterization of *Matheson*, Applicants respectfully submit that *Matheson* does not disclose the method to manage a change to a product structure of, for example, Applicants' claim 1, as presently amended.

In order to anticipate a claim, a reference must teach all limitations, arranged or combined in the same way as recited in Applicants' claim. The Court of Appeals for the Federal Circuit recently held

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.¹

Applicants have amended independent claim 1 to include limitations previously presented in amended claim 5. Amended claim 1 recites, *inter alia*,

[A]ssociating a second validity for the change with a second organizational structure, the second organizational structure having a second organizational view of the product structure, the second validity determining if the change is allowed by the second organizational structure and when the instructions to implement the change affect the product structure, and *wherein the second validity depends on the first validity*; and

automatically implementing the change, at the computer, according to the first validity for the first organizational view,

¹ *Net MoneyIn, Inc. v. Verisign, Inc.*, No. 2007-1565 at 17. (Fed. Cir. Oct. 20, 2008); emphasis added.

and according to the second validity for the second organizational view.²

Applicants other independent claim, claim 15, as amended, shares limitations similar to at least those indicated above. Applicants respectfully submit that *Matheson* does not disclose each and every element of independent claims 1 and 15. Therefore, these claims are not anticipated, and are thus novel.

In rejecting previously presented claim 5, the Examiner argued that *Matheson* at column 5, lines 53-61 discloses the limitation where “the second validity depends on the first validity.” Applicants respectfully disagree. Column 5, lines 53-61 of *Matheson* merely discusses relationships between data objects within an Innovation Information Management (IIM) object model. “For example, each Product Idea 110 may have associated with it various Product Requirements . . . which may each have zero or more associated Product Function objects 150 which fulfill (or partially fulfill) the requirement encapsulated in its associated Product Requirement object 120.”³ *Matheson*, however, does not disclose or even hint at having one product requirement *dependent on* another product requirement. In contrast, Applicants’ claimed elements recite a first validity and a second validity “*the second validity depending on the first validity.*”

Furthermore, *Matheson* is also silent on “automatically implementing the change, at the computer, according to the first validity for the first organizational view, and according to the second validity for the second organizational view.”⁴ The Examiner argued that this claim element is disclosed by *Matheson* at column 7, lines 7-10.⁵ However, this passage of *Matheson* merely discusses a “set of *decision-making interfaces allow a user to capture and track various decisions* made during the exploration phase of the product.”⁶ In particular, column 7, lines 7-10 of *Matheson* discuss an example ProductRequirementDecision interface that “allows the tracking of questions, answers, and resulting decisions related to the product requirement.”⁷ Clearly, capturing and tracking various questions, answers, and decisions is not the same as automatically

² Emphasis added.

³ *Matheson* at column 5, lines 53-61.

⁴ Emphasis added.

⁵ *Office Action* at 3 lines 15-19.

⁶ *Matheson* at column 7, lines 5-7.

⁷ *Matheson* at column 7, lines 7-10.

implementing a change. Applicants have been unable to find any portion of *Matheson* that discloses or even hints at this claim element.

Since Applicants have shown that not all the claimed elements were known as required by the *Net MoneyIn* court, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §102(e) with regard to independent claims 1 and 15. Further, since claims 2-14 and 16-28 depend, either directly or indirectly from claims 1 and 15, respectively, they too are allowable for at least the same reasons as the claims from which they depend. Further, these dependent claims may contain additional patentable subject matter.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5th day of March, 2010.

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Signature Dawn R. Shaw